



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/896,821 07/18/97 QUAY

S SNUS125

EXAMINER

HM12/0918

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HOLLINDEN, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/896,821

Applicant(s)

QUAY, STEVEN C.

Examiner

Gary E Hollinden, Ph.D.

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-37 is/are pending in the application.
- 4a) Of the above claim(s) 15-29 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30, 31, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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The request filed on July 6, 2000 for a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) based on parent Application serial No. 08/896,821 is acceptable and a CPA (with the same serial number) has been established. An action on the merits follows:

This Office Action is a response to the CPA filed on July 6, 2000. Currently, Claims 15-37 are pending in this application and claims 31, 32, 36 and 37 will be examined on their merits. Claims 15-29 remain withdrawn as not reading on the election.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Claims 30¹, 31, 32, 36, and 37 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time that application was filed, had possession of the claimed invention for reasons of record stated in the Office Action dated September 22, 1998.

Because no arguments were filed with the request for a CPA (Continued Prosecution Application) under 37 CFR § 1.53(d) filed on [1], this rejection is adhered to.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

¹Claims 30, 36, and 37 are only being examined to the extent that they read upon the elected invention. As noted before, when the instant species becomes allowable, a new species will be examined, etc. until the full scope of the pending claims are examined.

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 31, 32, 36 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. patent nos. 5,409,688, 5,393,524, 5,573,751, 5,558,854, 5,558,094, 5,558,855, and 5,558,853 because the instant elected composition is drawn to a specific sub-genus which would be encompassed within the broader claims of the cited patents for reasons of record stated in the Office Action dated September 22, 1998.

Applicant's agreement to file an appropriate terminal disclaimer filed on March 25, 1999 is acknowledged.

Claims 31, 32, 36 and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application serial no. 08/466,104, 08/646,910, 08/710,849, 08/770,522, 08/745,256, and 08/900,986. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant elected composition is drawn to a specific sub-genus which would be encompassed within the broader claims of the cited applications for reasons of record stated in the Office Action dated September 22, 1998.

Applicant's agreement to file an appropriate terminal disclaimer filed on March 25, 1999 is acknowledged.

The obviousness-type double patenting rejection, whether of the obviousness type or non-obviousness type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent².

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

²*In re Thorington*, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 214 USPQ 761 (CCPA 1982); *In re Longi*, 225 USPQ 645 (CA FC 1985); and *In re Goodman*, 29 USPQ 2010 (CA FC 1993).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 30 and 31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of the claims of copending application Serial No. 08/710,849. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented for reasons of record stated in the Office Action dated September 22, 1998.

Applicant's arguments filed on March 25, 1999 have been fully considered. Applicant is apparently making reference to the fact that if 08/710,849 is still pending when the instant claims become allowable, then this rejection should be withdrawn in this case and maintained in '849.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ...". Thus, the term "same invention," in this context means an invention drawn to identical subject matter³.

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are not longer coextensive in scope. The filing of terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

In view of the objections /rejections to the pending claims set forth above, no claims may be allowed at this time.

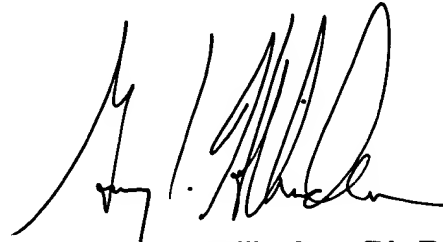
Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at 703/308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15 1989.

³*Miller v. Eagle Mfg.* 151 U.S. 186 (1894); *In re Ockert*, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 164 USPQ 619 (CCPA 1970).

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Any inquiry concerning this Office Action or any earlier Office Actions in this application should be directed to Dr. Gary E. Hollinden whose telephone number is 703/308-4521. Dr. Hollinden's office hours are from 6:30 am to 3:00 pm on Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-1235.

A handwritten signature in black ink, appearing to read 'Gary E. Hollinden', is positioned above the printed name.

Gary E. Hollinden, Ph.D.
Primary Examiner
Group 1600